



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of : DECISION
M. Asharaf Imam et al. :
Serial Number: 08/845,897 : ON
Filed: April 28, 1997 :
For: POROUS METAL/ORGANIC : PETITION
POLYMERIC COMPOSITES

This is a decision on Applicant's Petition filed May 15, 2001 under 37 CFR 1.181 for withdrawal of examiner's final rejection mailed March 12, 2001. The petition also requests reconsideration of non-entry of after final amendment submitted November 13, 2000.

Applicant petitions the examiner's refusal of entry of the after final amendment because the Examiner stated that the Amendment which sought to change the term from Comprising to "essentially consisting of" raised a new issue that would require further consideration. Applicant contends this statement is in error. Applicant states that in an interview with Exr Roche, the examiner of record, she stated that the term "consisting essentially of" would require a new search and that this transition language did not remove the ability to have "fillers" in the polymer matrix. The examiner is also said to have stated that the transition term, "consisting of" would possibly overcome the Tsang et al. reference and that applicant could file a CPA or 1.81 petition in order for more communication to occur. For this reason, applicant has filed the instant petition.

Applicant seeks relief because applicant does not agree that adding the term "consisting essentially of" would not require a new search. Applicant points to MPEP 2111.03 which states that consisting essentially of will be construed as equivalent to "comprising". The examiner of record has already performed a search involving the transition word "comprising". Therefore no new search is required. However, further consideration would be required and applicant has agreed with this statement.

Applicant is correct in his assertion that the insertion of consisting essentially of includes comprising. Therefore as applicant stated, the claims including "consisting essentially of" have already been searched. However, further consideration would be required. Applicant had submitted the amendment under 1.116 to overcome the rejection over Tsang. The Tsang reference includes the use of fillers that applicant claims would materially affect the fundamental character of the instant invention.

Applicant appears also to seek relief so that other amendments may be added which may overcome the rejections of Tsang and Reitz. The proposed amendments that would delete hardened rubbers and hardened silicone rubbers seek to narrow the scope of the claims that would then require further search and consideration.

Applicant seeks to continue prosecution after the appeal brief has been filed. This is not permissible. Applicant seeks to materially narrow the scope of the claim. Even though the claims have been searched to include "consisting essentially", the insertion of this amendment at this time would, contrary to applicant's assertion, narrow the scope of the claims. This is evidenced by applicant's statement that the Tsang reference would be overcome because then the instant claim could no longer include the fillers. There is also the question that if the fillers that applicant refers to do not materially affect the scope, then why would the fillers of Tsang materially affect the foam of the Tsang reference.

For these reasons, the petition is DENIED.

Sincerely,


Richard Fisher
Director, Technology Center 1700